REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks. Applicant appreciates the indication that the corrections to the specification and claims are adequate to remove the objections of the prior Office Action.

Several clarifying amendments have been made in preparation for appeal. Applicant requests the courtesy of an interview at the earliest possible date in hopes of avoiding the unnecessary cost and efforts required of the undersigned, the client and the Office in appealing the present application. Applicant's position is as noted below.

Regarding the Rejections under 35 U.S.C. §102

All claims (1-36) have been rejected as anticipated by the Draft EIA-775A, DTV 1394 Interface Specification (hereinafter EIA) submitted by Applicant. Applicant respectfully requests reconsideration of all rejections in view of the following:

Applicant appreciates the more detailed explanation of the rejection provided in the current Office Action, but reiterates the prior arguments by reference thereto. Applicant must respectfully disagree. As explained by the Examiner, the claims must be given their broadest reasonable interpretation. However, every word of the explicit language of the claims taken in light of the specification must be taken in consideration. Moreover, the prior art must actually place the invention in the possession of the public in order for the prior art reference to be anticipatory.

In the present case, the Examiner states "the means for delivery of the OSD depends on the capability of the DTV to process that image." The Examiner further states that if "the DTV determines that the size of a digital image that [sic] is larger than a predetermined size, it will return information to the producer device so that an analog image will subsequently [be] sent to the DTV instead of a digital image." It is respectfully submitted that these interpretations are the Examiner's improper hindsight speculation. The cited reference is silent as to any mechanism that might be used to determine a DTV's capability to process an image, and in particular is

silent as to any comparison of an image size with a threshold as such a mechanism. Such teaching is only present in Applicant's specification.

In fact, section 4.11 of the cited EIA specification states "[t]he DTV shall support the CONNECT command for the purpose of allowing an external device that has both analog and digital outputs to signal which of the two it wishes to process for display." Annex A provides an operational scenario at section A.1.B. in which a bitmap image is transmitted over an IEEE 1394 link to the DTV and the DTV is disclosed to mix the bitmap with the displayed video (steps 4 and 5). However, the undersigned is unable to find in the reference any teaching or suggestion of "determining that a digital bitmap image is larger in size than a threshold; converting the digital bitmap image to an analog image; and sending the analog image to the consumer device" as required, by way of example, in claim 1.

Using claim 1 as an example, in order to find anticipation in the cited EIA reference, the reference must disclose each and every claim feature within the bounds of the single reference. Claim 1, again by way of example requires: "determining that a digital bitmap image is larger in size than a threshold". The undersigned finds no teaching of making such a determination as called for in the claim, and no teaching of use of any threshold. Claim 1 further calls for "converting the digital bitmap image to an analog image". The undersigned finds no such action in the cited reference, and in particular no such action responsive to the comparison with a threshold in the cited reference. Claim 1 further calls for "sending the analog image to the consumer device". In this instance "the analog image" clearly refers to the converted image by virtue of antecedent basis. Applicant finds no such teaching in the cited reference. Hence, it is respectfully submitted that the cited art fails on multiple counts to establish a *prima facie* case of either anticipation or obviousness.

Applicant further submits that in addition to the above failures, the cited reference is not enabling as to the claims. It is noted by the CAFC in *Elan Pharms. Inc. v. Mayo Found. for Med. Educ. & Research,* 346 F.3d 1051, USPQ2d 1373 (Fed. Cir. 2003), that "[a] claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Although published subject matter is "prior art" for all that it discloses, in order to render an invention unpatentable, the prior art must enable a person of

ordinary skill to make and use the invention. *Beckman Instruments*, 892 F.2d at 1551. The "invention" in this regard is, of course, defined by what is claimed.

The Examiner's attention is further directed to a recent CAFC ruling in *In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005) No 04-1074 in which the CAFC stated "To render a later invention unpatentable for obviousness, the prior art must enable the later invention" (emphasis added). This recent ruling clarifies that not only must a reference be enabling for an anticipation rejection, but also for an obviousness rejection. It is respectfully submitted that the claims as submitted are neither anticipated nor obviated by the cited art due to the fact that there is no teaching or suggestion that the cited reference teaches making any comparison of a digital bitmap image with a threshold and converting the image to an analog image for transmission to a consumer device as a result of such comparison as claimed. Accordingly, withdrawal of the rejection and allowance are respectfully requested.

In order to clarify the language of the claims without any substantive impact, the present response submits several minor clarifying amendments. These amendments do not change the intent or meaning of the claims in any substantive way, but are submitted in order to assure that the claim language is crystal clear in preparation for appeal.

In addition to the above, Applicant reiterates his position in this matter below:

Specifically regarding Independent claims 1, 15, 23 and 26:

Using claim 1 as an illustrative example, the Office Action states that "*determining that digital bitmap image is larger in size than a threshold*", as called for by the claim, is found at least at p.13, sections 3.2.1 and 3.3 and asserts that "the application running on the AV Source will determine the means (e.g., analog or digital) for delivery of the OSD based on the delivery capability of the information returned from the DTV".

However, what EIA actually states is that "the application running on the A/V Source may use its NTSC analog video output as a display method for GUIs. It may overlay its own OSD onto the NTSC analog signal before delivery to the display." In other words, the A/V Source may use analog video as the display method for Graphical User Interfaces (GUI) and On Screen Displays (OSD). Applicant finds no further teaching relevant to this claim feature. In

particular, there is no teaching or suggestion of comparison with a threshold and conversion to an analog signal if the threshold is exceeded.

While EIA certainly provides for transmission of both analog and digital data from the A/V Source to the DTV, there is no teaching or suggestion of basing the selection of analog versus digital upon comparison of the size of a digital bitmap image to a threshold size. Moreover, the Office's explanation is inadequate to establish the requisite "articulated reasoning" with "rational underpinning" (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) on obviousness) to support any conclusion that the cited art teaches or suggests this claim feature. In other words, the Office's reasoning does not lead to a conclusion that comparison of a bitmap size to a threshold is the basis for selection of analog versus digital either explicitly or by implication. Rather, the Office's assertion is apparently that the decision as to whether to transmit analog versus digital is carried out in an application running on the A/V source based upon the capabilities of the DTV as determined by the A/V Source's ability to discover certain information relating to the DTV's capabilities using its discovery capability discussed in sections 3.3 and 9 of EIA (see second paragraph of page 2 of the Office Action). Applicant finds no solid support even for this position, but notes emphatically that this position, even if correct, does not meet or even suggest the claim feature at issue.

In order to establish that the claim is unpatentable under 35 U.S.C. §102, it is fundamental that each and every claim feature must be found explicitly or inherently in a single reference (see MPEP 2131), and each and every claim feature must be fully and properly considered. In this case, EIA fails to fairly teach or suggest the feature of comparison of a size of a digital bitmap image to a threshold as a mechanism for determination whether analog or digital transmission to the DTV is to be used as claimed (to paraphrase without intent of imposing limitations). Applicant finds no such teaching or suggestion in EIA. Hence, *prima facie* unpatentability of claim 1 has not been established.

Claims 15, 23 and 26 contain similar features and hence the above arguments are equally applicable. For example, in claims 15 and 23 the "determining" function is entirely analogous to that argued in connection with Claim 1. As to claim 26, there is no teaching or suggestion that

the resident or downloaded application and OSD generator of FIG. 3 carry out the function of determining if the size of the bitmap image exceeds a threshold as asserted.

In view of this failure to establish anticipation of claims 1, 15, 23 and 26, claims 2-14, 16-22, 24-25 and 27-36 are also submitted to be patentable for at least the same reasons as those discussed for claim 1. Other distinctions also exist, but need not be addressed in view of the Office's failure to meet its initial burden to establish unpatentability. Reconsideration and allowance of all claims are respectfully requested.

Concluding Remarks

The undersigned notes that many other distinctions exist between the cited art and the claims. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. No amendment made herein was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references. The amendments merely clarify and make explicit that which is implicit in the claims as filed and previously argued.

The undersigned has been explicitly instructed by his client to assure that the application is in condition for appeal, and the clarifying amendments are believed to place the claims in better condition for appeal, but only by virtue of enhancing clarity without substantive change.

Interview Request

In view of this communication, all claims are clearly in condition for allowance. The undersigned earnestly hopes to work with the Examiner to avoid the necessity of an appeal, and therefore again requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,

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